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Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10008248 -1

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Shell Simpson et alConfirmation No.: 7864Application No.: 10/033148Examiner: PokrzywaFiling Date: Oct 23, 2001Group Art Unit: 2625Title: **System And Method Of Identifying A Printer Output Tray**

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

01/11/2007 CNEGA1 00000026 082025 10033148
01 FC:1251 120.00 DA
02 FC:1402 500.00 DA

TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Oct 20, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 620. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

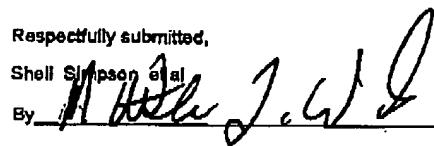
A duplicate copy of this transmittal letter is enclosed.

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Respectfully submitted,

Shell Simpson et al

By



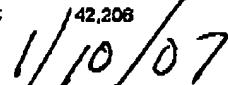
Matthew L Wade

Attorney/Agent for Applicant(s)

Reg No.:

42,208

Date:



Telephone:

208 396 5263

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Application Serial No. 10/033148
Confirmation No. 7864
Filing Date Oct. 23, 2001
Inventor Shell S. Simpson
Group Art Unit 2625
Examiner Joseph R. Pokrzywa
Attorney's Docket No. 10008248-1
Title:

APPEAL BRIEF

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 11-18 and 24-27 are pending. The rejection of Claims 16 and 26 are appealed. The rejection of Claims 11-15, 17, 24, 25 and 27 are not appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

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5. SUMMARY OF CLAIMED SUBJECT MATTER.

Independent claim 11, for example, provides for a server 132(specification, p. 5, line 23). The server 132 comprises a means for receiving a request from a client 132 (specification, p. 5, line 23-28). The server 132 further comprises a means for responding to the request 132 by transmitting a program 136 of computer readable instructions to the client 104 (specification, p. 5, line 23-33). The program 136 enables the client 104 to use a specific printer 106 having a plurality of output trays 139 to print a document 610 (specification, p. 5, line 29-33). The program 136 further enables the client 104 to display an indicator 604, 612 that indicates the identity of an output tray from the plurality of output trays 139 that receives the document (specification, p. 7, line 23-31). Claim 11 further specifies the server 132 is the printer 106 (specification, p. 3, lines 1-6).

Claim 16 depends from claim 11 and further specifies that the indicator 604, 612 of claim 11 further indicates the present capacity of the output tray that is receiving the document to accept additional media (specification, p. 9, lines 5-23).

Independent claim 24 provides a printer 106 having a plurality of output trays 139 (specification, p. 5, lines 19-23). The printer 106 comprises apparatus 132 for responding to a request received from a client 132 by transmitting a program 136 of computer readable instructions to the client 104 (specification, p. 5, line 23-33). The program 136 is for enabling the client 132 to use the printer 106 to print a document 610 and to display an indicator 604, 612 that indicates an output tray from the plurality of output trays 139 that receives the document. (specification, p. 5, line 29-33).

Claim 26 depends from claim 24 and further specifies the program 136 is further for enabling the client 104 to inform a user the present capacity of the output tray receiving the document (specification, p. 9, lines 5-23).

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6. GROUNDS OF REJECTION TO BE REVIEWED.

1. Claim 16 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Nozawa (U.S. Patent Number 6,781,709).
2. Claim 26 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Nozawa (U.S. Patent Number 6,781,709).

7. ARGUMENT.

For the discussion that follows, it is noted that the MPEP, at Section 2131, states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

GROUND NO. 1**A. Claim 16 was improperly rejected under 35 U.S.C. § 102(e) as being anticipated by Nozawa (6,781,709).**

Appellants contend that claim 16 was improperly rejected because Nozawa does not disclose all the elements and limitations of claim 16. Claim 16 depends from claim 11.

Claim 11 recites:

11. A server, comprising:
 - (a) means for receiving a request from a client;

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(b) means for responding to the request by transmitting a program of computer readable instructions to the client, the program for enabling the client to:

- i) use a specific printer having a plurality of output trays to print a document; and
- ii) display an indicator that indicates the identity of an output tray from the plurality of output trays that receives the document; wherein the server is the printer.

Claim 16 recites:

16. The server of claim 11, wherein the indicator further indicates the present capacity of the output tray that is receiving the document to accept additional media.

It is respectfully submitted that the 102 rejection of claim 16 should be withdrawn for at least the reason that Nozawa does not disclose at least the claim features that are highlighted in claim 16 above.

In the final rejection, and with regard to the limitation of claim 16, the Office stated that "Nozawa discloses the server discussed in claim 11, and further teaches that the indicator further indicates the present capacity of the output tray that is receiving the document to accept additional media (see Figs. 10, 12, 14 and 19, column 15, lines 28-column 16, line 31, and column 19, lines 19-51)". (Office Action, page 5, paragraph 1).

It is respectfully submitted that this is incorrect. These particular sections cited by the Office appears directed to dialog boxes that can be used to adjust printer settings. Nowhere does Nozawa describe an indicator that indicates the present capacity of the output tray that is receiving the document to accept additional media.

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Thus, Nozawa does not disclose all the elements and limitations recited in Applicant's claim 16. Therefore the rejection is improper at least for this reason and should be withdrawn.

GROUND NO. 2

B. Claim 26 was improperly rejected under 35 U.S.C. § 102(e) as being anticipated by Nozawa (6,781,709).

Appellants contend that claim 26 was improperly rejected because the Nozawa does not disclose all the elements and limitations of claim 26. Claim 26 depends from claim 24.

Claim 24 recites:

24. A printer having a plurality of output trays, comprising:
apparatus for responding to a request received from a client by transmitting a program of computer readable instructions to the client, the program for enabling the client to:
i) use the printer to print a document; and
ii) display an indicator that indicates an output tray from the plurality of output trays that receives the document.

Claim 26 recites:

26. The printer of claim 24, wherein the program is further for enabling the client to inform a user the present capacity of the output tray receiving the document.

It is respectfully submitted that the 102 rejection of claim 26 should be withdrawn for at least the reason that Nozawa does not disclose at least the claim features that are highlighted in claim 26 above.

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In the final rejection, the Office repeated for claim 26 the rationale that had been advanced with regard to claim 16, discussed heretofore. For similar reasons as stated above, Nozawa does not teach a program that is provided by a printer to a client where the program enables the client to inform a user of the present capacity of the output tray receiving the document. Accordingly, it is respectfully asserted that Nozawa does not teach the limitations of claim 26.

Thus, Nozawa does not disclose all the elements and limitations recited in Applicants claim 26. Therefore the rejection is improper at least for this reason and should be withdrawn.

Respectfully submitted,

Shell S. Simpson

Date: 1/10/07

By:

Matthew L. Wade
Matthew L. Wade
Attorney for Appellant
Reg. No. 42,206

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APPENDIX I -- CLAIMS INVOLVED IN THE APPEAL

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Claims 1-10 (canceled)

11. (previously presented) A server, comprising:

- (a) means for receiving a request from a client;
- (b) means for responding to the request by transmitting a program of computer readable instructions to the client, the program for enabling the client to:
 - i) use a specific printer having a plurality of output trays to print a document; and
 - ii) display an indicator that indicates the identity of an output tray from the plurality of output trays that receives the document;
wherein the server is the printer.

12. (canceled)

13. (original) The server of claim 11, wherein the indicator includes an image of the printer.

14. (original) The server of claim 11, wherein the indicator includes an image of the output tray that is receiving the document.

15. (original) The server of claim 11, wherein the client is a personal computer connected to the server over a network.

16. (original) The server of claim 11, wherein the indicator further indicates the present capacity of the output tray that is receiving the document to accept additional media.

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17. (original) The server of claim 11, wherein the indicator includes an animated image of the printer.

18. (original) The server of claim 11, wherein the program is Web content.

Claims 19-23 (canceled)

24. (original) A printer having a plurality of output trays, comprising:
apparatus for responding to a request received from a client by
transmitting a program of computer readable instructions to the client, the program for
enabling the client to:

- i) use the printer to print a document; and
- ii) display an indicator that indicates an output tray from the plurality of output trays that receives the document.

25. (original) The printer of claim 24, wherein the indicator includes an image of the printer.

26. (original) The printer of claim 24, wherein the program is further for enabling the client to inform a user the present capacity of the output tray receiving the document.

27. (original) The printer of claim 24, wherein the indicator includes an animated image of the printer.

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APPENDIX II -- EVIDENCE SUBMITTED UNDER RULES 130, 131 OR 132

none

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APPENDIX III – RELATED PROCEEDINGS

none

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